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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/098,204

Applicant(s)

UDELL ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,13-15,17-19 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,13-15,17-19,44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 1-10,13-15-17-19,44-47 are pending. In view of the Amendment filed on 7/23/04, PROSECUTION IS HEREBY REOPENED. The Non-Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19,44-47 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-43 of copending Application No. 10/216,979. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

('979) 20. A method for creating a virtual container containing a digital object, comprising the steps of (1)creating a virtual container, the virtual container residing in contiguous locations in an electronic storage media of a computer, the virtual container including a header portion and a digital object portion; selecting a digital object for (2)insertion into the virtual container; applying an encryption technique to the digital object to create (3)an encrypted digital object; writing the encrypted digital object into the digital object portion; (4)selecting an expiration date for the digital object; writing information indicative of the expiration date into the header portion of the virtual container.

(Application) a method for creating a self-destructing document, comprising the steps of:

(1)creating an executable module which instructs a computer to automatically delete the document to which the executable module is (2)attached when the document, based on (4)a preselected expiration date is expired;

attaching the executable module to the document, wherein the document is (3)an encrypted document, and wherein the executable module is configured to instruct the computer to decrypt the document is not expired, and to delete the document if the document is expired.

It was clearly that only an unexpired electronic document would be executed then decrypted and the expired information indicates the document should be deleted automatically or manually as a design choice.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10,13-15,17-19,44-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Hansen [Enhancing documents with embedded programs: How Ness extends insets in the Andrew Toolkit] in view of Martinez et al [Martinez 5,903,723].

4. As per claim 1, Hansen discloses a method for creating a self-destructing document, comprising the steps of

creating an executable module which instructs a computer to automatically delete only the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document

Hansen discloses an electronic message such as a birthday card with embedded or attached program which would be automatically executed (i.e.: delete a file, play song, lights a candle) based on a predetermined condition controlled by the program [Hansen, embedded scripts, page 28 col 2].

However Hansen fails to detail the preselected expiration date is expired and deleted file as the only attached document.

A skilled artisan would have motivation to implement the Hansen's application and found Martinez's teaching. Martinez taught a digital object is sent to buyer includes an expiration time which is automatically invalid after a deadline or preselected date [Martinez, col 22 lines 24-47].

An Official Notice is taken that in the prior art suggested a plurality of techniques which related to an electronic component contained a self-destruct or expired code [see Thompson taught a facility for permitting self-deleting programs (abstract). Haas taught a method of reuseable self-expiring badge wherein the inked used on badge substrate is expired after a specified time interval (abstract). Chamberlin taught a method and apparatus of voice email with self destruct restriction (Chamberlin, col 9 lines 25-38). Shear taught a database with a self-destruct feature (abstract). Wolfe taught a computer program with self-destruction code (abstract)].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of an electronic message was automatically deleted or invalid by an expiration date as taught by Martinez. It was clearly that by adding an expiration time into the transaction record or electronic message would make the record invalid after a deadline. Either the expired code was embedded into the message or attached to the message. In case of the expired code is embedded into the message, the message would be deleted or self-destructed when the date is expired. In case of the expired code is attached to the message, the expired

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code would delete the attachment. By doing so it would improve the security and reliability for message transaction and storage between client/server.

5. Claims 6-10,13-15 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15 are rejected.

6. As per claims 2-4, Hansen-Martinez disclose the executable module is an executable code, program, macro [Hansen, embedded scripts, page 28 col 2].

7. As per claim 5, Hansen-Martinez disclose the step of executing the executable module when the document is opened as inherent feature of embedded scripts.

8. As per claim 18, Hansen-Martinez disclose a method for creating a self-destructing document, comprising the steps of:

creating an executable module [Hansen, the multimedia mail, page 23 col 2; embedded scripts, page 28 col 2] which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a pre-selected expiration date is expired [Martinez, automatically invalid after a deadline, col 22 lines 24-47];

attaching the executable module to the document, wherein the document is an encrypted document [Hansen, embedded scripts, page 28 col 2], and wherein the executable module is configured to instruct the computer to decrypt the document is not

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expired, and to delete the document if the document is expired [Martinez, decrypt and automatically invalid after a deadline, col 22 lines 24-47]. It was clearly that only an unexpired electronic document would be executed and decrypted

9 Claim 19 contains the same limitations that were addressed in rejecting claim 18 above. By the same rationale applied above, claim 19 is rejected.

10 Claim 44, Hansen-Martinez disclose the executable modules overwrites the document with null characters as inherent feature of embedded script

11 Claim 45, Hansen-Martinez disclose selecting the preselected expiration date by selecting a number of days until expiration of the document as inherent feature of deadline.

12 Claims 46,47 Hansen-Martinez disclose selecting the month, date, year as inherent feature of deadline.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10,13-15,17-19,44-47 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Berkowitz et al [Berkowitz, 6,088,720].

9. As per claim 1, Berkowitz discloses a method for creating a self-destructing document, comprising the steps of :

creating an executable module based on a preselected expiration date is expired and deleted file as the only attached document; attaching the executable module to the document [Berkowitz, creating an email with attachment and an expiration date, col 2 line 12-col4 line 17];

It was obvious the executable program which instructs a computer to automatically delete only the document to which the executable module is attached when the document expired;

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Berkowitz's application by assigned the self-cleaning function into each attached file in order to utilize the automatic deletion of email after their useful life has expired. By doing so it would improve the self-cleaning process on mailbox because the program just self destruct only the expired email without interfere to other files of system.

10. Claims 6-10,13-15 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15 are rejected.

11. As per claims 2-4, Berkowitz discloses the executable module is an executable code, program, macro Berkowitz, creating an email with attachment and an expiration date, col 2 line 12-col 4 line 17].

12. As per claim 5, Berkowitz discloses the step of executing the executable module when the document is opened Berkowitz, creating an email with attachment and an expiration date, col 2 line 12-col 4 line 17].

13. As per claim 18, Berkowitz discloses a method for creating a self- destructing document, comprising the steps of:

creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a pre-selected expiration date is expired; attaching the executable module to the document, wherein the document is an encrypted document and wherein the executable module is configured to instruct the computer to decrypt the document is not expired, and to delete the document if the document is expired [Berkowitz, creating an email with attachment and an expiration date, col 2 line 12-col 4 line 17].

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9 Claim 19 contains the same limitations that were addressed in rejecting claim 18 above. By the same rationale applied above, claim 19 is rejected.

10 Claim 44, Berkowitz discloses the executable modules overwrites the document with null characters as inherent feature of self-cleaning process.

11 Claim 45, Berkowitz discloses selecting the preselected expiration date by selecting a number of days until expiration of the document as inherent feature of expiration date.

12 Claims 46,47 Berkowitz discloses selecting the month, date, year as inherent feature of expiration date.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-10,13-15,17-19,44-47 are rejected under 35 U.S.C. § 103 as being unpatentable over O'Tool Jr. et al [O'Tool, 6,279,112 B1] in view of Wolfe [4,796,220].

15. As per claim 1, O'Tool discloses a method for creating a code (i.e.: self-destructing document), comprising the steps of :

creating an executable module (i.e.: an applet) based on a preselected expiration date is expired and deleted file as the only attached document; attaching the executable module to the document [O'Tool, a Web document or electronic message containing an embedded executable coupon such as an ActiveX applet, an expiration date, a product code, col 6 lines 32-67];

However O'Tool fails to detail the code/script includes the executable program which instructs a computer to automatically delete only the document which is attached (i.e.: self-destruct);

A skilled artisan would have motivation to implement the attached program in O'Tool's application and found Wolfe's teaching. Wolfe taught a computer program with self-destruction code [Wolfe, abstract, self-destruction code, col 9 lines 12-32]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of an program contained an self-destruct code (i.e.: automatically deleted) by an expiration date as taught by Wolfe. It was clearly that by embedded program code would self destruct only itself after a deadline , expiration or predetermined condition. By doing so it would improve the security and reliability for message transaction and storage between client/server because the program just self destruct without interfere to other files of system.

16. Claims 6-10,13-15 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15 are rejected.

17. As per claims 2-4, O'Tool - Wolfe disclose the executable module is an executable code, program, macro [O'Tool, a Web document or electronic message containing an embedded executable coupon such as an ActiveX applet, an expiration date, a product code, col 6 lines 32-67].

18. As per claim 5, O'Tool - Wolfe disclose the step of executing the executable module when the document is opened [O'Tool, a Web document or electronic message containing an embedded executable coupon such as an ActiveX applet, an expiration date, a product code, col 6 lines 32-67].

19. As per claim 18, O'Tool - Wolfe disclose a method for creating a self- destructing document, comprising the steps of:

creating an executable module (i.e.: applet) which instructs a computer to automatically delete the document [Wolfe, abstract, self-destruction code col 9 lines 12-32] to which the executable module is attached when the document, based on a pre-selected expiration date is expired [O'Tool, a Web document or electronic message containing an embedded executable coupon such as an ActiveX applet, an expiration date, a product code, col 6 lines 32-67];

attaching the executable module to the document, wherein the document is an encrypted document [O'Tool, encrypt, col 6 lines 15-26; col 13 lines 60-65] and wherein the executable module is configured to instruct the computer to decrypt the document is not expired [O'Tool, decrypt, col 6 lines 15-26; col 13 lines 60-65], and to delete the

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document if the document is expired [Wolfe, abstract, self-destruction code col 9 lines 12-32].

9 Claim 19 contains the same limitations that were addressed in rejecting claim 18 above. By the same rationale applied above, claim 19 is rejected.

10 Claim 44, O'Tool - Wolfe disclose the executable modules overwrites the document with null characters as inherent feature of embedded applet coupon

11 Claim 45, O'Tool - Wolfe disclose selecting the preselected expiration date by selecting a number of days until expiration of the document as inherent feature of deadline.

12 Claims 46,47 O'Tool - Wolfe disclose selecting the month, date, year as inherent feature of deadline.

13 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-5,903,723. Thompson taught a facility for permitting self-deleting programs (abstract).

- 5,364,132. Haas taught a method of reuseable self-expiring badge wherein the inked used on badge substrate is expired after a specified time interval (abstract).

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- 5,003,575. Chamberlin taught a method and apparatus of voice email with self destruct restriction (Chamberlin, col 9 lines 25-38).

- 4,827,508. Shear taught a database with a self-destruct feature (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Rupal Dharja*, can be reached at (571) 272-3880. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

